

REMARKS

Claims 1-36 were present for examination in the above identified Reissue application. The application is objected to as lacking the written consent of the assignees. The Examiner notes that a prior consent signed by Link Door Controls, Inc. is in the file, but that a subsequent Assignment from Link Door Controls, Inc. to The Chamberlain Group, Inc. has been recorded. Applicant submits herewith for filing in the present application, a new Consent of Assignee listing the entire claim of title to The Chamberlain Group, Inc., and signed on behalf of The Chamberlain Group, Inc.

The Examiner states in paragraph 6 of the Office Action that claims 1-21 are allowed.

Claims 22-36 are rejected under 35 U.S.C. 251 as being improperly broadened in a Reissue application made and sworn to by the assignee and not the patentee. In response to a Notice to File Missing Parts of a Reissue application filed June 29, 2004, applicant submitted a Declaration signed by the inventor Walter Parsadayan. A copy of the inventor's Declaration is enclosed. Accordingly, applicant asserts that the patentee (inventor) has provided the documents required by 35 U.S.C. 251 and that such rejection is traversed.

The Examiner further notes that the reissue claims are broader than the original patent claims by not including a surrender-generating limitation and are barred by the recapture rule. The not included limitation referred to by the Examiner relates to the placement of the electronic communication device within a housing. Claim 22, the only added independent claim has been amended to include a limitation that the electronic communication device is within at least one housing. Thus, a broadened limitation regarding the placement of the electronic communication device in at least one housing is now present in claim 22.

MPEP § 1412.02 (Rev. 3 August 2005) provides an updated statement of the recapture rule. Section IC 2(d), reproduced below, provides that a reissue claim which includes a broader statement of a surrender invoking limitation than that of the issued patent is not subject to the recapture rule because the new claim is narrower than the cancelled claim subject matter.

"(d) Reissue Claims Broader in Scope in Area Directed to Amendment/Argument Made to Overcome Art Rejection in Original Prosecution; but Reissue Claims Retain, in Broadened Form, the Limitation(s) Argued/Added to Overcome Art Rejection in Original Prosecution:

Assume the combination AB was originally claimed in the application, and was amended in reply to an art rejection to add element C and thus provide the combination ABC (after which the patent issued). A reissue application is then filed, and the reissue application claims are directed to the combination ABC^{broadened}. The ABC^{broadened} claims are narrowed in scope when compared with the canceled claim subject matter AB, because of the addition of C^{broadened}. Thus, the claims retain, in broadened form, the limitation argued/added to overcome art rejection in original prosecution. There is no recapture, since ABC^{broadened} is narrower than canceled claim subject matter AB in an area related to the surrender. This is so, because it was element C that was added in the application to overcome the art. See *Ex Parte Eggert, supra.*" MPEP § 1412.02 IC2(d).

In terms of the above quoted MPEP section, amended claim 22 includes limitations of the type ABC^{broadened} and there is no recapture.

Claims 22-36 also stand rejected under 35 U.S.C. 103 as being unpatentable over combinations of U.S. Patent 5,982,861 to Holloway et al., U.S. Patent 5,303,288 to Duffy et al. and U.S. Patent 5, 973,666 to Challener et al.

Applicant's claim 22 recites a combination for use with a security system connected to a communication network. The claimed combination includes an input device, an electronic communication device comprising a sequential list of entries, an encoder, separate from the input device, which encoder is used to select an entry from the sequential list and scroll apparatus for scrolling through the list from the entry selected by the encoder.

Holloway et al., which is the primary reference, does not suggest or teach an encoder, for selecting an entry from the list. Duffy et al. is cited to show a jump function to select an entry, but the Duffy et al. jump function is enabled from its keyboard input device. Nothing in the combination of Holloway et al., or Duffy et al. suggests or teaches an encoder separate from the input device. Challener et al. is then cited because it shows a rotary dial.

Challener et al. does not relate to an analogous art and it does not teach or suggest use in conjunction with apparatus for strolling through a sequential list from an entry selected by the rotary switch. Challener et al. shows a television type channel changer switch attached to a

personal computer for selecting which of a plurality of computer programs is to be performed by the personal computer. Challener et al., does not teach or suggest scrolling by apparatus separate from the switch, for scrolling from a program selected by the switch. Basically, Challener et al. neither suggests inclusion in a combination of the type of applicant's claim 22 nor does it provide the function of the encoder in selecting an entry of a sequential list and interaction with a scrolling apparatus. Accordingly, Challener et al. is not a proper reference to include in the 35 U.S.C. 103 rejection of claim 22.

Even if Challener et al. is combined as a reference in the rejection the resulting combined references do not show an encoder, separate from the input device, for selecting an entry from a sequential list and further apparatus for scrolling through the sequential list.

In view of the foregoing, applicant asserts that claim 22 is allowable as it now stands. Accordingly, all claims 23-36 which depend from claim 22 are asserted to be allowable.

Additionally, claim 26 recites that the encoder has a plurality of positions, each position corresponding to a portion of the alphabet. The rotary switch of Challener et al. has positions which correspond to computer programs to be performed not to letters of the alphabet. For this further reason, claim 26 is not made obvious by the combined references.

The Commissioner is hereby authorized to charge any additional fees which may be required in this Application to Deposit Account No. 06-1135.

Respectfully requested,

FITCH, EVEN, TABIN & FLANNERY

By Kenneth H. Samples
Kenneth H. Samples
Registration No.: 25,747

Date: 12/16/05
120 South LaSalle Street
Suite 1600
Chicago, Illinois 60603-3406
Telephone: (312) 577-7000
Facsimile: (312) 577-7007